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OFFICE OF PETITIONS

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CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 101/2
EAST HANOVER NJ 07936-1080

In re Patent No. 7,544,354 : DECISION ON REQUEST
Wolfe, et al. : FOR
Issue Date: June 9, 2009 : RECONSIDERATION OF
Application No. 10/035,420 : PATENT TERM ADJUSTMENT
Filed: October 25, 2001 : and
Atty Docket No. **51460-US-NP** : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the petition filed on July 21, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by twenty-nine (29) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted **by two hundred and eighty-three (283) days is GRANTED to the extent indicated herein.**

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on October 26, 2004, and ends on February 1, 2006, the day before the RCE was filed, and is 464 (not 465) days. See 35 U.S.C. 154(b)(1)(B)(i).

It is noted that patentees failed to account for the filing of the notice of appeal on November 30, 2005. The Office reminds patentees that the period consumed by appellate review, whether

successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii). In this instance, the period consumed by appellate review is 64 days, beginning on the date on which the notice of appeal to the Board of Patent Appeals and Interferences was filed, November 30, 2005, and ending on the day before the Request for Continued Examination was filed, February 1, 2006. Thus, the B delay is 400 days (464 - 64). Accordingly, the patent term adjustment is 283 days (311 days of A delay + 400 days of B delay - 0 days of overlap - 428 days of applicant delay).

It is noted that the filing of the terminal disclaimer on July 15, 2008, has no effect on the determination of patent term adjustment set forth on this patent. It is true that 35 U.S.C. 154(b)(2)(B) provides that:

No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.

Moreover, 37 CFR 1.703(g) provides that:

No patent, the term of which has been disclaimed beyond a specified date, shall be adjusted under § 1.702 and this section beyond the expiration date specified in the disclaimer.

However, the provisions of § 154(b), for adjustment due to examination delay, apply to original applications, other than designs, filed on or after May 29, 2000. The Office calculates patent term adjustment for examination delay in all eligible applications. In calculating the patent term adjustment, the Office does not differentiate between applications that have terminal disclaimers and those that do not. Nor does the Office undertake the burdensome task of reviewing every application with a terminal disclaimer to determine if the patent term adjustment accorded would adjust the term beyond the expiration date specified in the disclaimer.

Rather, on issuance of the application, in compliance with 35 U.S.C. 154(b) and 37 CFR 1.703(g), it is indicated in the patent that the patent term adjustment indicated therein is subject to any disclaimer. Moreover, it is also stated therein that the patent is subject to a terminal disclaimer. Patentees must determine whether the submission of the terminal disclaimer will

prevent patentees from enforcing the days of patent term adjustment awarded.


The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required as per the decision mailed May 11, 2009.

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **two hundred and eighty-three (283) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3222.


Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,544,354 B2

DATED : Jun. 9, 2009

INVENTOR(S) : Wolfe et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (48) days

Delete the phrase "by 48 days" and insert – by 283 days--